

REMARKS

Claims 1 through 15, 17 through 20, 22, and 23 are pending in this Application.

Applicant acknowledges, with appreciation, the Examiner's allowance of claims 1 through 13 (subject to objections dealt with hereinafter). Claims 14, 17, 19, 22, and 23 have been amended and claims 16, 21, and 24 through 27 cancelled. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure noting, for example, that limitations of claim 16 have been incorporated into claim 14, and limitations from claim 21 have been incorporated into claim 19. Applicant submits that the present Amendment does not generate any new matter issue.

Claim Objections.

The Examiner objected to claims 1 and 13 identifying a perceived informality with respect to the wavelength. These objections are traversed.

Specifically, it would appear that the Examiner relied upon the published patent application rather than the actual patent application submitted to the USPTO. As indicated in original claims 1 and 13 appearing in this Amendment, the wavelength was designated by the symbol λ_a . However, for some reason which is not apparent, the symbol a_a erroneously appears in the published application.

Based upon the foregoing Applicant solicits withdrawal of the objection to claims 1 and 13.

Objection to the Disclosure.

The Examiner objected to the disclosure stating that in paragraph [0039], “P_u” should appear as “P_n” in equation 2. This objection is traversed. Specifically, submitted herewith as Exhibit A is a copy of page 8 of the disclosure originally filed in the USPTO, noting that in formula (2), “P_n” appears. Again, the Examiner appears to have relied upon the published patent application which regrettably contains an error, rather than the actually filed application.

Based upon the foregoing Applicant solicits withdrawal of the objection to the disclosure.

Claims 24 through 27 were rejected under the second paragraph of 35 U.S.C. § 112.

This rejection is traversed. Indeed, this rejection has been rendered moot by canceling claims 24 through 27.

Claims 14, 19, and 24 through 27 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Shimomura et al.

This rejection is traversed. Indeed, this rejection has been rendered moot by incorporating limitations from claim 16 into claim 14 and claim 21 into claim 19, claims 16 and 21 not being subject to this rejection, noting that claims 24 through 27 have been cancelled.

As apparently recognized by the Examiner, Shimomura et al. neither disclose nor suggest an optical multiplexer or optical demultiplexer as defined in independent claims 14 and 19, which specify ranges wherein insertion loss increases are defined directly and not defined through a variation of component signals. These ranges are neither disclosed nor suggested by Shimomura et al.

Based upon the foregoing Applicant solicits withdrawal of the rejection of claims 14, 19, and 24 through 27 under 35 U.S.C. § 102 for lack of novelty as evidenced by Shimomura et al.

Claims 15 and 20 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Shimomura et al. in view of Waarts et al.

This rejection is traversed. Specifically, claims 15 and 20 depend from claims 14 and 19, respectively. Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claims 14 and 19 under 35 U.S.C. § 102 for lack of novelty as evidenced by Shimomura et al. The secondary reference to Waarts et al. does not cure the previously argued deficiencies of Shimomura et al.

Accordingly, even if the applied references are combined as proposed by the Examiner, and Applicant does not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Applicant, therefore, submits that the imposed rejection of claims 15 and 20 under 35 U.S.C. § 103 for obviousness predicated upon Shimomura et al. in view of Waarts et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 16 through 18 and 21 through 23 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Shimomura et al.

This rejection is traversed.

Initially, Applicant will treat this rejection as though imposed against claims 14 and 19, since the limitations of claims 16 and 21 have been incorporated into claims 14 and 19, respectively. As previously pointed out, Shimomura et al. neither disclose nor suggest an optical

multiplexer or optical demultiplexer which specify ranges wherein insertion loss increases are defined directly, and are not defined through a variation of component signals. There is absolutely no factual basis upon which to predicate the conclusion that one having ordinary skill in the art would have been realistically impelled to modify the optical device disclosed by Shimomura et al. to arrive at the claimed invention. *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002); *In re Kotzab*, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

Applicant would note that in rejecting claims 16 through 18 and 21 through 23, the Examiner acknowledged shortcomings of Shimomura et al. and then, without more, announced the obviousness conclusion. This approach constitutes clear legal error. *In re Lee*, *supra*; *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998).

Applicant, therefore, submits that the imposed rejection of claims 16 through 18 and 21 through 23 under 35 U.S.C. § 103 for obviousness predicated upon Shimomura et al. is not factually or legally viable and, hence, solicits withdrawal thereof.

Applicant again acknowledges, with appreciation, the Examiner's allowance of claims 1 through 13. Based upon the arguments submitted *supra*, it should be apparent that the imposed objections and rejections have been overcome, and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

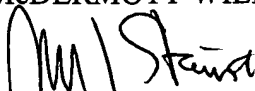
To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

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including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read 'Arthur J. Steiner', is written over the printed name.

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